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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,257	02/22/2005	Thomas Aue	SCH-15904	5004
40854 7590 12/12/2007 RANKIN, HILL, PORTER & CLARK LLP 38210 Glenn Avenue WILLOUGHBY, OH 44094-7808			EXAMINER NIA, ALIREZA	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/525,257

Applicant(s)

AUE, THOMAS

Examiner

Alireza Nia

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on March 21, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 02/22/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonnet 5,685,853.**

3. With respect to claim 1, Bonnet teaches a device comprising a main body 1.0 traversed by an optics guide 1.1 of a slide carriage 1.6 being proximally affixed to said main body 1.0 (fig. 1), an inner shaft 2.0, and an outer shaft 1.2, said outer shaft 1.2, which encloses said inner shaft 2.0 and which is detachable by an externally actuated outer connector element 2.4, being mounted on said main body 1.0 and extending distally, wherein the outer connector element 2.4 is connected to the main body via 1.8 (col. 3, lines 21-50 and col. 4, lines 26-35).

4. With respect to claim 2, Bonnet further teaches the inner shaft 2.0 is affixed to the main body 1.0 via 2.4, 1.8 (col. 4, lines 10-15).

5. With respect to claim 3, Bonnet further teaches the inner shaft 2.0 is detachably affixed to the main body by an inner connector element 2.3 (col. 4, line 31).

6. With respect to claim 4, Bonnet further teaches the inner shaft 2.0 is affixed in a borehole 1.2 of the main body 1.2 via 2.4, 1.8 (col. 3, line 39-45).

7. With respect to claim 5, Bonnet further teaches the inner shaft 2.0 is affixed to a proximal terminal zone 1.8 of outer shaft 1.2 (col. 4, lines 31-35).

8. With respect to claim 6, Bonnet further teaches the inner shaft is detachably affixed by an inner connector element 2.3 to a proximal terminal zone 1.8 of the outer shaft 1.2 (col. 4, lines 31-35).

9. With respect to claim 7, Bonnet further teaches the inner shaft 2.0 comprises a connector element 2.4 engaging the outer connector element 1.8 between the outer shaft 1.2 and the main body 1.0 (figs. 3,4,6).

**10. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller 5,486,155.**

11. With respect to claim 1, Muller teaches a resectoscope 10 (col. 2, line 15) comprising a main body 26,28 (col. 2, line 36) traversed by an optics guide 14 of a slide carriage 114 (col. 2, line 27) being proximally affixed to said main body 26,28 via 38,54, an inner shaft 20, and an outer shaft 22, said outer shaft 22, which encloses said inner shaft 20 and which is detachable by an externally actuated outer connector element 38,39, being mounted on said main body 26,28 and extending distally (fig. 2), wherein the outer connector element 38,39 is connected to the main body 26,28 (fig. 2 and col. 2, lines 34-57).

12. With respect to claim 2, Muller further teaches the inner shaft 20 is affixed to the main body 26,28 via 38,39,80 (fig. 2).

13. With respect to claim 3, Muller further teaches the inner shaft 20 is detachably affixed to the main body 26,28 by an inner connector element 50 (col. 2, lines 49-58).

14. With respect to claim 4, Muller further teaches the inner shaft 20 is affixed in a borehole 39 of the main body 22,28 or 26,28 (col. 2, lines 34-57).

15. With respect to claim 5, Muller further teaches the inner shaft 20 is affixed to a proximal terminal zone 38 of outer shaft 22 via 26,28 (fig. 2).

16. With respect to claim 6, Muller further teaches the inner shaft 20 is detachably affixed by an inner connector element 50,80 to a proximal terminal zone 38 of the outer shaft 1.2 (fig. 2).

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muller 5,486,155 in view of Wallace 2,532,043.**

19. Muller discloses the invention as discussed above. However, Muller does not positively disclose the inner shaft to comprise a connector element engaging the outer connector element between the outer shaft and the main body.

20. Wallace teaches an inner shaft which comprises a connector element 14 engaging an outer connector element between an outer shaft via 12 and a main body (fig. 4).

21. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the device of Muller in view the limitations taught by Wallace in order to provide a surgical instrument for the retrograde resection of tumorous growths in the vicinity of the bladder neck (col. 2, lines 36 et seq. 44-46).

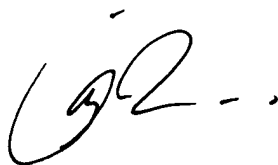
***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Wosnitza 2003/0144662.**

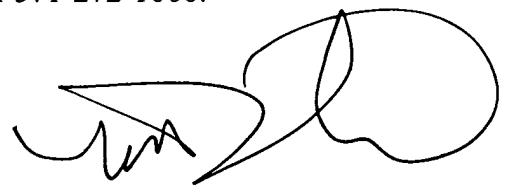
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alireza Nia whose telephone number is 571-270-3076. The examiner can normally be reached on Mo.-Fri.-7:30 AM-5:00 PM EST-Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alireza Nia  
December 5<sup>th</sup>, 2007



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